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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,756	12/21/2001	Monica A. McClintic	5082US (01-01-057)	2572
4743	7590	04/14/2005	EXAMINER	
MARSHALL, GERSTEIN & BORUN LLP 6300 SEARS TOWER 233 S. WACKER DRIVE CHICAGO, IL 60606			MOSSER, ROBERT E	
			ART UNIT	PAPER NUMBER
			3714	

DATE MAILED: 04/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action Before the Filing of an Appeal Brief	Application No. 10/028,756	Applicant(s) MCCLINTIC, MONICA A.	
	Examiner Robert Mosser	Art Unit 3714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) a set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Attached.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

Art Unit: 3714

Applicant challenges the rejection of claims 41-58 based on the USC 103 combination of Turner (US 4684136), Walker (US 6193606) and Marnell (5,393,057). Specifically applicant challenges the following items:

I) *Applicant challenges the enablement of a free space in a trivia game as disclosed by Marnell.*

However, ^{MARNELL} ~~Marnell~~ presents the inclusion of a "wild" or "free" space in the center tile of the matrices for three separate and distinct embodiments presented in at least figures one through three and in addition to stating "the primary gaming device 22 could be...a trivia quiz game" (Col 3:61-62) further states "...games which have a plurality of events which occur and which can be given different values...are particularly well suited for use as the primary gaming device" (Col 3:62-68). The isolation of trivia questions to different values by equivalent subject, difficulty, or probability of occurrence are not understood to be lacking from the reference when considered in view the alternative embodiments shown and the disclosure when considered in whole.

Further, as set forth in section 2121.01(II) of the MPEP "a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 USC 103." As presented this removes the burden of enablement when a reference is applied under 35 USC 103 thus making this challenge moot.

II) *Applicant suggests that only improper hindsight could yield the presented combination of references as applied to the applicant's claimed invention (First full paragraph page 4).*

In reply the MPEP 2145(X) sets forth the criteria for the evaluation of hindsight with the following citation, "However, "[a]ny judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper." In re McLaughlin 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

Applicant has failed to demonstrate any proper challenge under improper hindsight as set forth above.

III) *Applicant argues that the combination of Marnell with Turner and Walker "does not ring true with the statements made by Turner." (Page 4 first full paragraph)*

First the Turner contains no reference or statement barring the use of a number arrangements greater or less than three, therefore contains no grounds for the alteration of the number of arrangements to be considered destructive. The mere fact that Turner teaches three arrangements does not bar the application of Turner as prior art in a game that might contain a different number of arrangements under 35 USC 103.

Second the arrangements Turner refers to in particular are three arrangements of a particular subject (ex Math. History Science) wherein each subject is further constructed of nine positions (Figure 1 & Col 1:64-2:7 & Col 3:13-22). Hence the alteration of a particular tic-tac-toe grid subject through the inclusion of a free space would clearly be unrelated to any disclosure of Turner regarding the completion of three subject grids.

Remainder arguments directed to claims 59-76 are reliant on the points addressed above and refuted on the same basis.



JESSICA HARRISON
PRIMARY EXAMINER